

REMARKS

Reconsideration and allowance of the above referenced application, in view of the following remarks, are respectfully requested. Claims 1-22 are pending in the application. Claims 1-22 stand rejected. New Claim 23 has been added.

Rejections Under 35 U.S.C. § 103

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy (U.S. Patent No. 6,260,024) in view of Giovannoli (U.S. Patent No. 5,758,328). Applicants respectfully traverse this rejection and request withdrawal thereof for at least the reasons set forth below. Applicants respectfully submit that no *prima facie* case of obviousness has been established. As the Examiner is aware, a *prima facie* case of obviousness requires the following: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP at 2143. Applicants submit that one or more of these criteria have not been met.

With regard to the first criterion, Shkedy and Giovannoli fail to provide any motivation to modify the references individually to try to arrive at the invention recited in each of the present claims. As noted by the Examiner, Shkedy does not teach or suggest the purchase and sale of telecommunication services where one or more sellers reply to buyer solicitations and the buyer selects service from the one or more sellers. In addition, the Examiner acknowledges that Shkedy does not disclose requests from buyers leading to offers from sellers, which buyers

may or may not choose to accept. Giovannoli does not teach or suggest many aspects of the claimed invention but most notably it does not relate to telecommunication services.

Additionally, there is no motivation in the references to combine them with one another. The Examiner has not shown any indication in Giovannoli that it is analogous prior art to buying and selling telecommunication services. In fact, Giovannoli and Shkedy teach away from one another. For example, Shkedy causes the seller after placing a bid on a pooled purchase order “PPO” to enter into a “legally binding contract” with an intermediary. (*See* Shkedy col. 6, lines 27-28). Giovannoli, on the other hand, discloses buyer requests for quotations from sellers. (*See* Giovannoli, col. 2, lines 35-37). In Giovannoli the seller is not capable of entering into a “legally binding contract” because his response to the buyer’s request is merely a quote which the buyer may accept or reject. The two procedures are entirely different with different motivations by both buyer and seller under the two scenarios. The Examiner’s comments on pages 8-9 of the Action conceding that Shkedy’s method is different from the present invention but are acknowledged. However, the Applicants dispute the Examiner’s assertion that Shkedy’s shortcomings are remedied by Giovannoli, particularly because each reference teaches away from the other. It would therefore be improper to combine the references. *See* MPEP at 2145 X.D.2. (It is improper to combine references where the references teach away from their combination). Moreover, it appears that only using improper hindsight would one seek motivation to combine the references.

The state of the telecommunication industry at the time the present application was filed also demonstrated the lack of motivation to combine Shkedy and Giovannoli. For example, thousands, perhaps millions, of Americans receive telephone solicitations offering various telephone services on a daily basis. Many of these calls are unwanted altogether, others are

taken by consumers who then switch telephone services based on intimidation, “quick selling”, or cheap enticements such as limited rebates, free minutes, or small cash offers. An industry of telemarketers revolves around this process. Consumers have beckoned for change. (See the January 21, 2000, comments by Colorado Attorney General, Ken Salazar at <http://www.ago.state.co.us/PRESREL/presrl00/prsrl4.htm> attached hereto as Exhibit A). The U.S. government is bereft with ideas of how to solve the problems associated with telephone solicitations, except to work with and monitor the telephone companies. The present inventors recognized the problems and offered a novel, pro-active, and consumer oriented solution by way of the present application, which heretofore has not been presented to the public. Giovannoli does not even recognize the demand for telecommunication reform, much less offer solutions to these problems. Shkedy fails to recognize the importance of buyer requests generating seller offers. The motivation to combine these two references simply did not exist. The gap was simply too large between the combined Giovannoli and Shkedy disclosures. The failure of the telecommunication industry to recognize the gap is evidenced by the continuing public and governmental outcry for services provided by the claimed invention.

Even if for some reason Shkedy and Giovannoli were combined, despite there being no motivation to do so, the Office Action does not establish that one would have been even further motivated, having no knowledge of the invention at issue, to make further modifications and to combine the references in a particular manner to try and arrive at the claimed invention. See *In re Kotzab*, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The Action alleges that the elements of Shkedy when combined with Giovannoli would “suggest Applicant’s invention to one of ordinary skill in the art.” This hindsight analysis, however, does not establish a *prima facie* case, as motivation to modify must be found in the references themselves. The Examiner has

provided no evidence as to why one skilled in the art would be motivated to attempt to translate the systems of Shkedy and Giovannoli into the present invention. A statement that modifications of the prior art to meet the claimed invention allegedly would have been “within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon allegedly teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (MPEP 2142.01). The question is not whether the combination of Shkedy and Giovannoli are capable of performing the claimed invention (which they are not), but rather if the reference themselves teach or suggest the claimed process. They do not.

Additionally, the second prong of the obviousness analysis requires that the references provide a reasonable expectation of success if the modification is in fact made, which Giovannoli and Shkedy do not provide. The reasonable expectation of success must be found in the prior art, not in the Applicants’ disclosure. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). There is no indication in Shkedy or Giovannoli that would lead one to conclude that there was a reasonable expectation of successfully translating Shkedy and Giovannoli into a process for buying and selling telecommunication services. It appears that impermissible hindsight is being used to ascertain an expectation of success. As discussed above, the references expressly teach away from one another in terms of their approach toward the initial engagement between buyer and seller in a buyer-driven process. Shkedy discloses binding offers from buyers. Giovannoli discloses buyer requests for quotations from sellers. Consequently, the Applicants assert that this prong of a *prima facie* obviousness case has also not been established.

The Examiner further addresses Claims 2, 4, 7, 8, and 9 separately under the auspices of this rejection. Claims 2, 4, 7, 8, and 9 depend either directly or indirectly from Claim 1. Applicants submit that for at least the same reasons, Claim 1 is unobvious over Giovannoli and Shkedy, Claims 2, 4, 7, 8, and 9 are likewise unobvious.

For at least these reasons, Applicants respectfully submit that the present invention is neither anticipated by nor obvious in view of Shkedy and Giovannoli. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 3 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli and further in view of Felt (U.S. Patent No. 6,128,742). Felt is cited for its alleged teaching of assigning a password to a group. Felt does not make up for the deficiencies of Shkedy and Giovannoli, which do not suggest the claimed invention for at least the reasons discussed above. Felt discloses a method of authenticating the identity of a first party involved in communicating over a computer network system. *See* Abstract. One combining Shkedy, Giovannoli and Felt (despite there being no motivation to make such a combination) would not achieve the claimed invention, which as discussed herein is specific to telecommunication services and achieves a novel method of aggregating buyers and requesting quotes from sellers of telecommunication services. Accordingly, for at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli as applied to Claim 1 and further in view of official notice. Applicants submit that for at least the same reason, Claim 1 is unobvious over Giovannoli and Shkedy, Claim 5 is likewise unobvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

B

Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli as applied to Claim 1 and further in view of the article entitled “Bell Offers Answers for Commonly Asked Questions” (hereinafter “Bell”). The Examiner alleges that Bell teaches “that whether customers are required to pay a deposit for new telephone service depends on whether they have had prior credit problems with the telephone company.” However, nowhere does Bell teach or suggest “obtaining information regarding prior use of telecommunication services of the group, the information regarding the prior use being included in the request.” Suggesting that it would be a good idea to run a credit check does not teach or suggest the system of Claim 1 including “obtaining information regarding prior use of telecommunication services of the group, the information regarding the prior use being included in the request,” either alone or in combination with the elements of underlying Claim 1. By including information regarding prior use in the request, telecommunication service providers can determine how good of an offer to make to the aggregated group of customers based in part on the information regarding prior use. For example, information regarding prior use may include the types of services used, the volume of services used, the times when services are used, etc. Thus, an aggregated group of customers may not only become more attractive because they are an aggregated group but also because the information regarding prior use by the group makes them a more attractive customer. The combination of the recited elements of Claim 6 with the recited elements of Claim 1 therefore present unique advantages to the present invention, and are in no way taught or suggested by Bell, either alone or in combination with Giovannoli and Shkedy. Additionally, there is no suggestion in any of the recited art to combine the teachings of Bell with Giovannoli or Shkedy. Further, Bell does not make up for the deficiencies of Shkedy and Giovannoli as discussed above. Applicants submit that for at



least these reasons and the reasons stated above with regard to Claim 1, Claim 6 is unobvious over the cited references. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy and Giovannoli as applied to Claim 1 and further in view of official notice. Official notice is taken to try and demonstrate that it is well known to present to buyers contractual terms and conditions for a service from a particular provider. However, the official notice does not make up for the deficiencies of Giovannoli and Shkedy. Applicants submit that for at least the same reasons Claim 1 is unobvious over Giovannoli and Shkedy, Claim 10 is likewise unobvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy in view of Giovannoli. Claim 11 is rejected on essentially the same grounds as Claim 1. Applicants submit that for at least the same reasons Claim 1 is unobvious over Giovannoli and Shkedy, Claim 11 is likewise unobvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 12-22 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shkedy in view of Giovannoli, and further in view of official notice in the case of Claims 6 and 21, further in view of Felt in the case of Claim 14, and further in view of Bell in the case of Claim 17. The Examiner rejects Claims 12-22 for essentially the same reasons that Claims 1-10 were rejected. Applicants submit that for at least the same reasons, Claims 1-10 are unobvious Claims 12-22 are likewise unobvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

New Claim 23

Applicant respectfully requests that the Examiner allow new Claim 23. New Claim 23 is not disclosed, taught or suggested by any of the cited references, either alone or in combination. Nowhere do the cited references teach or suggest “a computer-implemented method, comprising aggregating a plurality of buyers for purchasing at least one telecommunication service as a group; obtaining information regarding prior use of the at least one telecommunication service by at least one of the plurality of buyers; generating a request for purchasing the at least one telecommunication service, the request including the information regarding the prior use; presenting the request to a plurality of providers of telecommunication services; receiving replies from the providers in response to the request; presenting the replies to at least one of the buyers in the group; receiving a selection from the at least one buyer in response to the replies; and notifying a provider of the selection.”

Applicants submit that the claimed invention is not rendered obvious by any of the cited references alone or in combination. Applicants respectfully submit that the present invention is in condition for allowance and allowance is respectfully requested. If the Examiner has any questions regarding this submission or if an interview at this time would further the progress of this application to a favorable conclusion, please contact the undersigned at the telephone number provided.



A request is hereby made under 37 C.F.R. § 1.136 for the necessary extension of time. Both a one month extension fee and a fee for additional independent Claim 23 are believed due and submitted with these papers. If, however, any additional fees are deemed necessary, including any fees required under 37 C.F.R. § 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 50-2816. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

PATTON BOGGS LLP

Date: September 9, 2003

By: 

Darren W. Collins
Reg. No. 44,625

Patton Boggs, LLP
2001 Ross Avenue
Dallas, TX 75201
Telephone: (214) 758-3552 (direct)
Fax: (214) 758-1550

A request is hereby made under 37 C.F.R. § 1.136 for the necessary extension of time. Both a one month extension fee and a fee for additional independent Claim 23 are believed due and submitted with these papers. If, however, any additional fees are deemed necessary, including any fees required under 37 C.F.R. § 1.136 for any necessary extension of time to make the filing of the attached documents timely, please charge or credit the difference to Deposit Account No. 50-2816. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

PATTON BOGGS LLP

Date: September 9, 2003

By: 

Darren W. Collins
Reg. No. 44,625

Patton Boggs, LLP
2001 Ross Avenue
Dallas, TX 75201
Telephone: (214) 758-3552 (direct)
Fax: (214) 758-1550